

REMARKS

Applicants respectfully request reconsideration of the instant application in view of the amendments, herein, and the following remarks:

The following claims are *pending*: 1-268.

The following claims are *independent*: 1, 58, 116, 173, 230, 236, 242, 248, 254.

Please *amend* claims 1, 58, 116, 173, 230, 236, 242, 248, 254; although these claims have been amended herein to provide clarification, correct typographical inaccuracies and/or informalities, and/or to better track practical/commercial implementations/practices, Applicants submit that the originally filed claims are patentable and reserve the right to pursue the originally filed claims (as well as any claims dependent therefrom) at a later time and/or in one or more continuation/divisional application(s). Applicants submit that these new claims and/or claim amendments are supported throughout the originally filed specification and that no new matter has been added by way of these amendments.

Claim Rejections - 35 U.S.C. § 101

The Office Action has rejected claims 1-115, 230-241 and 254-268 under 35 U.S.C. § 101 as directed to non-statutory subject matter. Applicants respectfully traverse this rejection. Applicants submit that there is no test for non-statutory subject matter that subjectively precludes the aforementioned claims. MPEP § 2106, Section IV, states “claims directed to nothing more than abstract ideas (such as mathematical algorithms), natural phenomena, and laws of nature are not eligible for patent protection.” MPEP § 2106 also discusses “[w]hile abstract ideas, natural phenomena, and laws of nature are not eligible for patenting, methods

and products employing abstract ideas, natural phenomena, and laws of nature to perform a real-world function may well be.”

Applicants submit that the elements recited in the claims are, in fact, directed to statutory subject matter and do not fall within the recognized Judicial Exceptions as merely abstract ideas (such as mathematical algorithms), natural phenomena, and/or laws of nature. Though Applicants respectfully traverse the Examiner’s rejection and reserve the right to argue patentability of the claims in their original form at a later time, Applicants have amended independent claims 1, 58, 230, 236 and 254 to provide clarification and/or to better track business practices. Amended claim 1 recites, inter alia, a “creative work evaluating processor-implemented method” and “totaling via a processor.” Amended claim 58 recites, inter alia, a “creative work evaluating processor-implemented system” and “means to total via a processor.” Amended claim 230 recites, inter alia, an “evaluation reporting processor-implemented method” and “updating via a processor.” Amended claim 236 recites, inter alia, an “evaluation reporting processor-implemented system” and “means to update via a processor.” Amended claim 254 recites, inter alia, a “medium readable by a processor” and “access fields storing parameters.” Applicants submit claims 2-57, 59-115, 231-235, 237-241, and 255-268, which depend directly or indirectly from independent claims 1, 58, 230, 236 and 254 respectively, are directed to statutory subject matter for at least the reasons discussed above. Should the Examiner maintain the rejection, Applicants respectfully request that the Examiner provide specific explanation describing how claims 1-115, 230-241 and 254-268 are allegedly directed to non-statutory subject matter. Accordingly, for at least these reasons,

Applicants submit that claims 1-115, 230-241 and 254-268 are directed to statutory subject matter and withdrawal of this ground of rejections is requested.

Claim Rejections - 35 U.S.C. § 102

The Office Action rejected claim(s) 1-4, 6-10, 12, 14, 20, 25-26, 29-31, 35, 39, 45-47, 58-61, 63-67, 69, 71, 77, 82-83, 86-89, 93, 97, 103-105, 116-119, 121-125, 127, 129, 135, 140-141, 144-146, 150, 154, 160-162, 173-176, 178-182, 184, 186, 192, 197-198, 201-203, 207, 211, 217-219, 254-258, 260-268 under 35 U.S.C. § 102(e) as anticipated by Paul, US Patent Application No. 2003/0171982 (hereinafter “Paul”).

With regard to this and the other noted references, Applicants do not concede that said reference predates the conception/reduction to practice of Applicants’ invention nor do Applicants concede it is an appropriate reference. However, in order to advance prosecution, Applicants respectfully traverse the rejection and submit that a showing of anticipation has not been made and that Paul does not discuss every element of the noted claim(s).

Applicants submit Paul does not discuss or render obvious at least the following element(s) as recited, *inter alia*, in independent claim 1:

A creative work evaluating processor-implemented method, comprising:
 providing an offer to compete, wherein the offer to compete includes parameters that specify a potential competitor and competition rules;
 ...

The Office Action asserts the above claimed elements are shown in Paul (paragraph 16) and alleges:

Paul discloses... providing an offer to compete to a potential competitor (see paragraph 16, disclosing a web site that offers registrants the opportunity to compete); (Office Action, p. 7).

Applicants disagree with the Examiner's characterization of the cited reference.

Instead of the Examiner's assertions, Applicants submit that Paul essentially discusses *chat room areas with limited participant capacity* where competitions may take place. Paul discusses "there will normally be a chat area, where members may converse one on one or in groups with each other," (Paul, paragraph [0015]). In Paul, "there will be some maximum number of individuals who may participate in a particular competition," (Paul, paragraph [0015]). As Paul teaches chat room interactions, there is simply no facility nor concept of "...the offer to compete includes parameters that specify a potential competitor and competition rules," as recited in claim 1.

Accordingly, Applicants submit that Paul's *chat room areas with limited participant capacity* where competitions may take place is different from at least the claimed "providing an offer to compete, wherein the offer to compete includes parameters that specify a potential competitor and competition rules," as recited in claim 1. For at least the reasons discussed above, Applicants submit that the pending rejection has mischaracterized the language of the claim element and/or the applied reference and, thus, has not established a case of anticipation.

The MPEP prescribes that, "when evaluating the scope of a claim, *every limitation in the claim must be considered*," (§ 2106 II(C), emphasis added) and, "*All words* in a claim must be considered in judging the patentability of that claim against the prior art." (§

2143.03, emphasis added). Applicants submit that the pending rejection has failed to consider “every limitation in the claim” and “[a]ll words in [the] claim” in judging the patentability of the claim against the prior art by mischaracterizing claim elements and/or over-generalizing the applied reference(s).

Accordingly, Applicants submit that a showing of anticipation has not been established and respectfully request reconsideration and withdrawal of this basis of rejection and allowance of the claim(s). Should the Examiner maintain the rejection, Applicants respectfully request that the Examiner provide specific citations and explanations describing how each and every element of the pending claims are allegedly anticipated by the cited reference, providing indications of specific, alleged correspondences between claim elements and cited portions of the applied reference.

Because the pending rejection has not established a *prima facie* case of anticipation by neglecting and/or mischaracterizing claim elements and because the applied reference does not discuss or render obvious at least the claim elements discussed above, Applicants respectfully request reconsideration and withdrawal of this basis of rejection.

As such, Applicants respectfully submit that at least these claim elements are not anticipated by Paul. Although each of claims 58, 116, 173, 254 are different in scope, Applicants submit that each of these claims is also patentable over the cited reference(s) for at least similar reasons as discussed above. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejection and allowance of the claims (and as a consequence any claims depending therefrom).

Claim Rejections - 35 U.S.C. § 103

The Office Action rejected claims 5, 22-24, 27, 33-34, 62, 79-81, 84, 91-92, 120, 137-139, 142, 148-149, 177, 194-196, 199, 205-206 under 35 U.S.C. § 103(a) as being unpatentable over Paul, and in further view of Jokipii et al, US PG Publication No. 2003/0190960 (hereinafter "Jokipii"). The Office Action rejected claims 15-16, 19, 21, 32, 40-41, 44, 72-73, 76, 78, 90, 98-99, 102, 130-131, 134, 136, 147, 155-156, 159, 187-188, 191, 193, 204, 212-213, 216 under 35 U.S.C. § 103(a) as being unpatentable over Paul, and in further view of Official Notice. The Office Action rejected claims 11, 13, 17-18, 28, 36-38, 42-43, 48-50, 54, 68, 70, 74-75, 85, 94-96, 100-101, 106-108, 112, 126, 128, 132-133, 143, 151-153, 157-158, 163-165, 169, 183, 185, 189-190, 200, 208-210, 214-215, 220-222, 226, 259 under 35 U.S.C. § 103(a) as being unpatentable over Paul, and in further view of Foroutan, US Patent No. 7,162,433 (hereinafter "Foroutan"). The Office Action rejected claims 51-53, 109-111, 166-168, 223-225 under 35 U.S.C. § 103(a) as being unpatentable over Paul, in view of Foroutan, and in further view of Jokipii. The Office Action rejected claims 55-57, 113-115, 170-172, 227-229 under 35 U.S.C. § 103(a) as being unpatentable over Paul, in further view of Foroutan, and in further view of Von Kohorn, US Patent No. 5,916,024 (hereinafter "Von Kohorn").

Although different in scope, Applicants submit that these claims, which depend directly or indirectly from independent claims 1, 58, 116, 173, 254, are also not discussed or rendered obvious by Paul and the other references taken alone or in combination, for at least similar reasons as those discussed in 35 U.S.C. § 102 remarks identifying deficiencies in the applied references with regard to the independent claims (e.g. none of the above references overcomes the deficiencies of Paul nor do they teach "providing an offer to compete, wherein

the offer to compete includes parameters that specify a potential competitor and competition rules," as recited in claim 1). Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejection.

The Office Action rejected claims 230-233, 236-239, 242-245, 248-251 under 35 U.S.C. § 103(a) as being unpatentable over Jokipii, and in further view of Foroutan.

Applicants respectfully traverse these rejections and submit that a *prima facie* showing of obviousness has not been made and that the applied references, taken alone or in combination, fail to discuss or render obvious every element of each noted claim(s).

MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate;
- (B) the difference or differences in the claim over the applied reference(s);
- (C) the proposed modification of the applied reference(s) to arrive at the claimed subject matter; and
- (D) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made. (MPEP § 706.02(j))

Applicants submit that the rejections in the pending Office Action do not establish at least requirement(s) (A) and/or (B) of a *prima facie* showing of obviousness.

Applicants submit Jokipii does not discuss or render obvious at least the following element(s) as recited, *inter alia*, in independent claim 230:

- A evaluation reporting processor-implemented method, comprising:
 - updating via a processor rankings for competitors and creative works, wherein the rankings are based on evaluations of

creative works from accepted offers to compete, wherein the accepted offers to compete included parameters that specified a potential competitor and competition rules...;

...

The Office Action asserts the above claimed elements are shown in Jokipii (paragraphs 50-51) and alleges:

Jokipii discloses... updating rankings for competitors (see paragraphs 50-51); (Office Action, p. 28).

Applicants disagree with the Examiner's characterization of the cited reference.

Instead of the Examiner's assertions, Applicants submit that Jokipii essentially discusses a *chat room based online gaming system*. For example, Jokipii discusses that "the Yahoo! Games section of the Yahoo! Web site provides users access to a multitude of gaming choices," (Jokipii, paragraph [0005], also see Jokipii, Figures 2-7). In Jokipii "a user can create a game room," (Jokipii, paragraph [0022]). Applicants note that Jokipii discusses that "users can determine whether there are any game tables that they can join or whether any games that might be interesting to view are being played," (Jokipii, paragraph [0046]). However, Applicants note that there is simply no concept in Jokipii of "...accepted offers to compete, wherein the accepted offers to compete included parameters that specified a potential competitor and competition rules ...," as recited in claim 230.

Accordingly, Applicants submit that Jokipii's *chat room based online gaming system* is different from at least the claimed "updating via a processor rankings for competitors and creative works, wherein the rankings are based on evaluations of creative works from accepted offers to compete, wherein the accepted offers to compete included parameters that

specified a potential competitor and competition rules...,” as recited in claim 230. Similarly, Applicants submit that Foroutan’s *system that allows producers to submit content for ranking* fails to remedy the deficiencies identified above in Jokipii with regard to independent claim 230. For at least the reasons discussed above, Applicants submit that the pending rejection has mischaracterized the language of the claim element and/or the applied reference(s) and, thus, has not established a *prima facie* case of obviousness.

The MPEP prescribes that, “when evaluating the scope of a claim, *every limitation in the claim must be considered*,” (§ 2106 II(C), emphasis added) and, “*All words in a claim must be considered in judging the patentability of that claim against the prior art*.” (§ 2143.03, emphasis added). Applicants submit that the pending rejection has failed to consider “every limitation in the claim” and “[a]ll words in [the] claim” in judging the patentability of the claim against the prior art by mischaracterizing claim elements and/or over-generalizing the applied reference(s).

Accordingly, by neglecting and/or mischaracterizing claim elements, Applicants submit that a *prima facie* showing of obviousness has not been established and thus the applied reference(s) do not discuss or render obvious at least these claimed elements. As such, Applicants respectfully request reconsideration and withdrawal of this basis of rejection and allowance of the claim(s). Should the Examiner maintain the rejection, Applicants respectfully request that the Examiner provide specific citations and explanations describing how each and every element of the pending claims are allegedly rendered obvious by the cited reference, providing indications of specific, alleged correspondences between claim elements and cited portions of the applied reference.

Although of different scope than claim 230, Applicants submit that claims 236, 242, 248 are patentable over Jokipii in view of Foroutan, taken alone or in combination, for at least similar reasons as discussed above identifying deficiencies in the applied references with regard to independent claim 230. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejection.

Furthermore, Applicants submit that claims 231-233, 237-239, 243-245, 249-251, which depend directly or indirectly from independent claims 230, 236, 242, 248 respectively, are also not discussed or rendered obvious by Jokipii, which discusses, *chat room based online gaming system*, and Foroutan, which discusses, *system that allows producers to submit content for ranking*, taken alone or in combination, for at least similar reasons as those discussed above identifying deficiencies in the applied references with regard to the independent claims. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejection.

CONCLUSION

Consequently, the reference(s) cited by the office action do not result in the claimed invention, there was/is no motivation, basis and/or rationale for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed inventions are not admitted to be prior art. Also, Applicants do not accept, acknowledge, and/or concede any Official Notice taken in the Office Action. Thus, the Applicants respectfully submit that the supporting remarks and claimed inventions, claims 1-268, all: overcome all rejections and/or objections as noted in the office action, are patentable over and discriminated from the cited reference(s), and are in a condition for

allowance. Furthermore, Applicants believe that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art. While many other claim elements and/or bases for rejection were not discussed as they have been rendered moot based on the above amendments and/or remarks, Applicants assert that all such remaining and not discussed claim elements and/or bases for rejection, all, also are distinguished over the prior art and reserve the opportunity to more particularly traverse, remark and distinguish over any such remaining claim elements and/or bases for rejection at a later time, should it become necessary. Further, any remarks that were made in response to an Office Action objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to another Office Action objection and/or rejection as to any other claim element(s), any such re-assertion of remarks is not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim elements, and no such commonality is admitted as a consequence of any such re-assertion of remarks. As such, Applicants do not concede that any claim elements have been anticipated and/or rendered obvious by any of the cited reference(s) and/or any Official Notice. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection(s) and/or objection(s), and allowance of all claims.

Authorization

Applicants hereby authorize and request that the Commissioner charge any additional fees that may be required for consideration of this and/or any accompanying and/or necessary papers to Deposit Account No. 03-1240, Order No. 19778-002. In the event that an extension of time is required (or which may be required in addition to that requested in a petition for an extension of time), Applicants request that the Commissioner grant a petition for an extension of time required to make this response timely, and, Applicants hereby authorize and request that the Commissioner charge any fee or credit any overpayment for such an extension of time to Deposit Account No. 03-1240, Order No. 19778-002.

In the event that a telephone conference would facilitate examination of the application in any way, Applicants invite the Examiner to contact the undersigned at the number provided.

Respectfully submitted,
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